

Attorney Docket No. 43890-489
PATENT

#9

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Continuation Reissue Application of:)
Reissue Application Ser. No. 09/558,462,)
Which Is Reissue of U.S. Pat. No. 5,764,622)
Serial No.: 10/014,431)
Filed: December 14, 2001)
Inventor: Ichiro KAWAMURA et al.)
For: RECORDING MEDIUM CARTRIDGE AND)
SIGNAL RECORDING APPARATUS)

Customer No. 20277
Confirmation No: 9874

Group Art Unit: 2653

Examiner: D. OMETZ

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APR 14 2005

Technology Center 2600

PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT

Mail Stop Petition
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants respectfully request that the NOTICE OF ABANDONMENT ("NOTICE") dated March 28, 2005 be withdrawn and that the response filed on March 4, 2003 be considered. Although Applicants believe that no fee is necessary, the Commissioner is authorized to charge Deposit Account No. 500417 the amount of any necessary fee to cover the Petition.

On March 31, 2005, Applicants' attorney received the aforementioned NOTICE (copy enclosed), which indicated that the above-identified application went abandoned for failing to respond to an Office Action mailed on December 4, 2002.

However, on March 4, 2003, Applicants' attorney filed a response to the aforementioned Office Action. A copy of the response, along with the date-stamped postcard indicating receipt thereof by the U.S. Patent and Trademark Office ("USPTO") is enclosed herewith. The response was filed concurrently with a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent, an Offer to Surrender Under 37 C.F.R. § 1.178 and a Supplemental Declaration Pursuant to 37 C.F.R. § 1.175(b)(1). It would appear that the response was inadvertently misplaced by the USPTO.

In view of the foregoing evidence, Applicants respectfully submit that the December 4, 2002 Office Action was responded to in a timely manner, and therefore the above-identified application was improperly abandoned.

In view of the above, Applicants respectfully request a withdrawal of the Notice of Abandonment issued in the instant application, and either entry of the response previously filed on March 4, 2003 or re-issuance of the December 4, 2002 Office Action with a new date for response be mailed to Applicants' attorney.

Respectfully submitted,

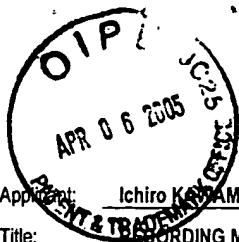
MCDERMOTT WILL & EMERY LLP

Date: 4/8/05

By: 

Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W., Suite 1200
Washington, D.C. 20005
Telephone: 202-756-8000
Facsimile: 202-756-8087
WDC99 1065609-1.043890.0489

Applicant: Ichiro K. KAMURA, et al.Docket No. 43890-489Title: RECORDING MEDIUM SIGNAL RECORDING APPARATUS Serial/Reg./Patent No. 10/014,431Date Sent: 3/4/2003 ☒ Hand Carried ☐ Fax ☐ Electronic ☐ Cert. of Mailing ☐ Express Mail No. _____☐ Transmittal LetterNew Patent App ☐ Utility ☐ Design ☐ Cont. ☐ CIP ☐ Div. ☐ PCT ☐ CPA ☐ RCE ☐ Prov☐ Other: _____

_____ pages of Specification

_____ pages of Claims

_____ pages of Abstract

_____ pages of Formal/Informal Drawings

☐ Small Entity ☐ Large Entity☐ Declaration/Power of Attorney☒ Recordation of Assignment/Security Agreement☐ Information Disclosure Statement

_____ Form PTO 1449

_____ copies of cited references

☐ Preliminary Amendment☐ Response to Missing Parts Notice☐ Resp. to Notice to Correct App. Papers☐ Certified Copy of Priority Doc.☐ Claim for Convention Priority☒ Response/Amendment to Office Action of 4DEC02☐ Request for _____ month Extension of Time☐ Letter submitting _____ pages of drawings☐ Req. for Approval of Drawing Amendments☐ Req. for Oral Hearing☐ Not. of Appeal ☐ Appeal Brief ☐ Reply Brief☐ Rule 312 Amendment/Letter☐ Req. for Acknowledgement of Cited Art☐ Issue Fee☐ Publication Fee☐ Req. for Certificate of Correction☐ Maintenance Fee for _____ years after grant☐ Fee Address Indication Form☒ Terminal Disclaimer☐ Petition to Commissioner☐ Status Inquiry☐ Other Offer to Surrender Under 37 CFR 1.178 and☒ Supplemental Declaration Pursuant to 37 CFR 1.175(b)(1)

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Check for \$		<input checked="" type="checkbox"/> Charge Deposit Acct.50-0417	\$110.00	Atty Init.	MEF	Tkpr. #	3328	Secy. or PL:	RPase
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CMS Descrip.: (23) = \$110.00

THE PATENT AND TRADEMARK OFFICE DATE STAMPED HEREON IS ACKNOWLEDGEMENT THAT THE ITEMS, CHECKED ABOVE, WERE RECEIVED BY THE PTO ON THE DATE STAMPED.



FILE

PATENT
ATTORNEY DOCKET NO. 43890-489

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Con Reissue Application of: Attn: BOX REISSUE
Ichiro KAWAMURA et al.

Serial No.: 10/014,431

Group Art Unit: 2653

Filed: December 14, 2001

Examiner: D. OMETZ

For: RECORDING MEDIUM CARTRIDGE AND SIGNAL RECORDING APPARATUS

AMENDMENT TRANSMITTAL

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Honorable Commissioner of Patents
and Trademarks,
Washington, D.C. 20231

Technology Center 2600

Sir:

1. X Transmitted herewith is an amendment for the above-identified application.

STATUS

2. X Applicant is is small entity - verified statement:
 attached already filed.
X other than a small entity.

EXTENSION OF TIME

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. §1.136 apply.

- (a) Applicant petitions for an extension of time for the total number of months checked below:

EXTENSION (months)	FEE FOR SMALL ENTITY	FEE FOR OTHER THAN SMALL ENTITY
<u> </u> one month	\$ 55.00	\$ 110.00
<u> </u> two months	205.00	410.00
<u> </u> three months	465.00	930.00
<u> </u> four months	725.00	1,450.00

Fee \$

If an additional extension of time is required, please consider this a petition therefor.

 An extension for months has already been secured and the fee paid therefor of is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this Request \$

- (b) X Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition for extension of time.

4. X The fee for claims has been calculated as shown below:

	Claims Remaining After Amendment	Highest Number Previously Paid For	Present Extra	Rate	Additional Fee
Total	:	:	:	:	:
Claims	: 9	: 25	: 0	: x \$ 18.00 =	: 0.00
Independent	:	:	:	:	:
Claims	: 4	: 4	: 0	: x \$ 84.00 =	: 0.00
Multiple Dependent Claims (first presentation)	:	:	:	: \$280.00 =	: 0.00
			Total	=	: 0.00
			Reduction by 1/2 for small entity	:	: 0
			TOTAL FEE	:	: \$ 0.00

- (a) X No additional fee for claims is required.

-OR-

- (b) The total additional fee for claims required \$

FEE PAYMENT

5. Attached is a check in the amount of \$.

 Charge Deposit Account No. 50-0417 the amount of \$. A duplicate copy of this Transmittal is enclosed for accounting purposes.

FEE DEFICIENCY

- X If any additional extension and/or fee is required, this is the request therefor and to charge Deposit Account No. 50-0417.

AND/OR

- X If any additional fee for claims is required, charge Deposit Account No. 50-0417. A duplicate copy of this Transmittal is enclosed for accounting purposes.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

Date:

3/4/03

By:

Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W., Suite 1200
Washington, D.C. 20005-3096
(202) 756-8000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Continuation Reissue Application of:)
Reissue Application Ser. No. 09/558,462,)
Which Is Reissue of U.S. Pat. No. 5,764,622)
Serial No.: 10/014,431)
Filed: December 14, 2001)
Inventor: Ichiro KAWAMURA et al.)
For: RECORDING MEDIUM CARTRIDGE AND)
SIGNAL RECORDING APPARATUS)

ATTN: BOX REISSUE

Group Art Unit: 2653

Examiner: D. OMETZ

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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT**

Honorable Commissioner of Patents
and Trademarks
Washington, D. C. 20231

Sir:

The owner, Matsushita Electric Industrial Co., Ltd. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior U.S. Patent No. RE37,659. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

The undersigned is an attorney of record and therefore the certification under 37 CFR 3.73(b) is not required.

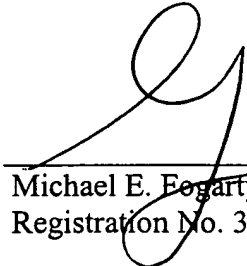
Please charge the Terminal Disclaimer fee (37 CFR 1.20(d) of \$110.00 to Deposit Account

No. 50-0417. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment associated with this communication to Deposit Account 50-0471.

Respectfully submitted,

McDERMOTT, WILL & EMERY

Dated: 3/4/03

By: 
Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W., Suite 1200
Washington, D.C. 20005-3096
Telephone: (202) 756-8000
Facsimile: (202) 756-8087

WDC99 702301-1.043890.0489

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In: Continuation Reissue Application of:)
Reissue Application Ser. No. 09/558,462,)
Which Is Reissue of U.S. Pat. No. 5,764,622)
Serial No.: 10/014,431)
Filed: December 14, 2001)
Inventor: Ichiro KAWAMURA et al.)
For: RECORDING MEDIUM CARTRIDGE AND)
SIGNAL RECORDING APPARATUS)

Group Art Unit: 2653

Examiner: D. OMETZ

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Technology Center 2600

OFFER TO SURRENDER UNDER 37 C.F.R. § 1.178

Hon. Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The undersigned Applicants of the accompanying application for a continuation reissue application of U.S. Letters Patent No. 5,764,622 for "RECORDING MEDIUM CARTRIDGE AND SIGNAL RECORDING APPARATUS", granted on June 9, 1998, of which Matsushita Electric Industrial Co., Ltd. is now the sole owner by Assignment and, on whose behalf and with whose assent the accompanying application is made, hereby confirm that the original letters patent was surrendered on February 6, 2001 in Reissue Application Serial No. 09/558,462, USP No. RE37,659. Accordingly, although the original letters patent was not lost, it is no longer in

the possession of the Applicants and therefore cannot be resubmitted to the USPTO.

Ichiro Kawamura Ichiro Kawamura Date: February 24, 2003

Ryoichi Imanaka Ryoichi Imanaka Date: February 24, 2003

Yoshikazu Goto Yoshikazu Goto Date: February 24, 2003

WDC99 526335-1,043890.0489

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Continuation Reissue Application of:)
Reissue Application Ser. No. 09/558,462,)
Which Is Reissue of U.S. Pat. No. 5,764,622)
Serial No.: 10/014,431)
Filed: December 14, 2001)
Inventor: Ichiro KAWAMURA et al.)
For: RECORDING MEDIUM CARTRIDGE AND)
SIGNAL RECORDING APPARATUS)

Group Art Unit: 2653

Examiner: D. OMETZ

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SUPPLEMENTAL DECLARATION PURSUANT TO 37 C.F.R. §
1.175(b)(1)

Hon. Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

We declare:

THE INVENTORS

1. That we, Ichiro Kawamura, Ryoichi Imanaka and Yoshikazu Goto reside at the addresses listed below, and declare that we are citizens of Japan; that we are employed by Matsushita Electric Industrial Co., Ltd. of Osaka Japan; that Matsushita is the Assignee of the entire interest of the above-identified patent; that at the time the application for the above-identified Patent was filed we were engaged in the design of recording mediums as described in United States Letters Patent No. 5,764,622 ("original patent"), that we do not know and do not believe that the invention was ever known or used in the United States before our invention; and that we are the declarants, applicants and patentees, referred to hereinafter.

2. That we believe that we are the original, first and sole inventors of the subject matter of the invention, which is claimed and for which a reissue patent is sought in the above-identified reissue application.

3. That we, Ichiro Kawamura, Ryoichi Imanaka and Yoshikazu Goto, are joint inventors of the subject matter claimed in the original patent, as well as the subject matter set forth in the claims contained in the reissue application.

4. That we believe the original patent to be wholly or partly inoperative or invalid, by reason of our claiming less than we had a right to claim.

5. New claims 6-14, as amended, recite patentable subject matter not claimed in the original patent, or the parent reissue application, USP No. RE37,659. Each of claims 6-14, as amended, expressly recite that the "detector" forms a part of the claimed signal recording apparatus. None of the claims of the original patent or parent reissue application included this limitation. More specifically, while each of the original claims and the claims of the parent reissue recited that the "indicator" provided an indication to an "electrical detecting device", the claims did not require the "electrical detecting device" to be part of the signal recording apparatus. Thus, we claimed less than we had a right to claim. New claims 6-14 cure this defect by expressly stating that the recited "detector" is part of the signal recording apparatus.

6. That we believe that the error regarding our narrow claiming of the invention arose inadvertently and without deceptive intent.

7. The instant reissue application is a continuation application of Reissue Application Serial No. 09/558,462, which was filed on April 24, 2000 and which has issued as USP No. RE37,659.

8. In accordance with 35 U.S.C. § 119, we claim the benefit of a foreign filing date on the basis of Japanese Patent Application Nos. 7-123420 and 8-122948, filed on May 23, 1995 and May 17, 1996, respectively. A certified copy of each priority document was filed in the parent application that issued as U.S. Patent No. 5,754,622.

9. That we hereby state that we have reviewed and understand the contents of the above-identified reissue application, including the amendments to the claims.

10. On December 4, 2002 an Office Action issued stating that our original Declaration filed on December 14, 2001 was defective for failing to specify at least one error, which can be relied upon to support the reissue application. The instant Supplemental Declaration is being submitted in an effort to correct the foregoing deficiencies in the original Declaration.

11. That we acknowledge the duty to disclose information of which we are aware which is material to the examination of the application for the above-identified reissue application in accordance with 37 C.F.R. § 1.56(a).

12. Every error in the patent which was corrected in the patent reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intent.

We declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: February 24, 2003

Ichiro Kawamura: Ichiro Kawamura

Address: 13-20, 2-chome, Yamasaka,
Higashisumiyoshi-ku, Osaka-shi,
Osaka 546-0035 Japan

Date: February 24, 2003

Ryoichi Imanaka: Ryoichi Imanaka

Address: 3-2-6, Kuzuhamisaki, Hirakata-shi,
Osaka 573-1112 Japan

Date: February 24, 2003

Yoshikazu Goto: Yoshikazu Goto

Address: 1-10-11, Nishikinya, Hirakata-shi,
Osaka 573-1192 Japan

WDC99 702355-1.043890.0489



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,431	12/14/2001	Ichiro Kawamura	43890-489	9874



7590 03/28/2005
McDermott, Will & Emery
600 13th Street, N.W., Suite 1200
Washington, DC 20005-3096

EXAMINER

OMETZ, DAVID LOUIS

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 03/28/2005

8

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
MAR 31 2005
MW&E

RECEIVED
APR 14 2005
Technology Center

Notice of Abandonment

Application No.

10/014,431

Examiner

David L. Ometz

Applicant(s)

KAWAMURA ET AL.

Art Unit

2653

The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 12/4/02.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:



David L. Ometz
Primary Examiner
Art Unit: 2653

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.